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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,500	07/12/2001	John K. Eckl	F-278	5429

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/903,500

Applicant(s)
Eckl

Examiner
James W. Myhre

Art Unit
3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 13, 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 14-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 12 and 14-36 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on June 13, 2002 has been considered but is ineffective to overcome the Comesanas (5,802,498) and Hogan (5,699,528) references.

37 CFR 1.131 Affidavit

2. The affidavit filed on June 13, 2002 under 37 CFR 1.131 (131 affidavit) has been considered but is ineffective to overcome the Comesanas (5,802,498) reference.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Comesanas reference to either a constructive reduction to practice or an actual reduction to practice.

The affidavit confirms the timeline of the previously filed 37 CFR 1.132 (132 affidavit) affidavit from Lawrence E. Sklar which discloses that the Applicant filed an inventive disclosure with the Intellectual Property and Technology Law Department of his employer on June 13, 1995, including a diagram of the invention completed on May 16, 1995. The 132 affidavit discloses that in early September 1995 a novelty search was conducted in which various references were gathered. This gap of approximately 8 weeks can be excused as part of the normal "workflow" within a law office. However, no action seems to have been taken on this invention during the next 5 months until the Pitney Bowes Production Mail Internal Patent Committee meeting in

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February 1996. The results of this meeting, according to the 132 affidavit was to agree to further evaluate and investigate this invention. During a subsequent meeting in June 1996 it was decided to prepare and file a United States patent application. From the time of this meeting until the actual filing of the application on December 23, 1996, numerous meetings, telephone calls, and other contacts were made between the inventor and the committee. The Examiner agrees that there was due diligence from the February 1996 meeting until the filing of the application in December 1996. However, due diligence has not been proven during the five months between September 1995 and February 1996. While it is not unreasonable to expect the preparation of a patent application to take an interval of several months, the delay of over 18 months from the filing of the inventive disclosure by the application and the submission of the patent application seems excessive. The 132 affidavit from the counsel would normally be expected to set forth dates establishing progress towards filing. However, the 132 affidavit show no progress during five months (Sep 95 - Feb 96), thus due diligence has not been established from a date prior to Comesanas' filing date to the application filing date. Therefore, the 131 and 132 affidavits are insufficient to overcome Comesanas.

Claim Objections

4. The amendment filed on June 13, 2002 corrected the errors in claims 16, 27, 28, and 29 objected to in paragraph 4 of paper number 4. Therefore, the Examiner hereby withdraws these objections.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498).

Claims 12 and 18: Comesanas discloses an automated billing system and method comprising:

- a. A billing server to receive billing information (col 2, lines 55-66);
- b. A routing means for processing/routing the information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);
- c. A printer connected to the server (col 3, lines 4-24 and col 4, lines 50-53);
- d. An electronic information server to convert the billing information for electronic transmission and to transfer the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53); and
- e. A lookup table containing delivery preferences for at least one customer.

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While Comesanas does not explicitly disclose that the delivery preferences of the customer(s) are maintained in a lookup table, it is inferred that this information is being stored in some type of data file. Since Comesanas explicitly discloses that the system will “determine whether each of the debtors has signed an agreement to pay transmittal charges (col 4, lines 44-46)(for electronic transmission) and will determine “whether each of said invoices is to be sent electronically or by mail” (col 4, lines 50-52), it is inherent that the system must look up both preferences, using one of the standard “lookup” devices in the database arts such as lookup tables.

Comesanas also does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas’ system was being converted to the proper format for printing or electronic transmission.

Claim 14: Comesanas discloses an automated billing system and method as described in Claim 12 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 15: Comesanas discloses an automated billing system and method as in Claim 12 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

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Claims 17 and 20: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses a means to transmit funds to the biller (col 3, lines 13-24).

Claim 19: Comesanas discloses an automated billing system and method as described in Claim 18 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database. However, Comesanas does not explicitly disclose that the customers' preferences are stored as a lookup table in the database. Official notice is taken that it is old and well known within the database art to place use a table format to save memory space when storing such data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a table to store the customer's selection of delivery means. One would have been motivated to use a lookup table in order to minimize the amount of memory required to store the information for a large number of customers. By placing the data in a table, each customer's file could have a one-bit identifier for the type of delivery instead of a much larger field to store the delivery instructions.

Claims 21, 26, 30, and 32: Comesanas discloses an automated billing system, apparatus, and method comprising:

- a. Accessing billing information comprising a plurality of records (col 2, lines 55-66) corresponding to one recipient;
- b. Isolating each record from the billing information (col 2, lines 55-66);

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- c. Extracting delivery preference information from the database for each record (col 3, lines 17-24 and col 4, lines 50-52);
- d. Determining whether each record is intended for printed or electronic transmission based on delivery preference information (col 3, lines 17-24 and col 4, lines 50-52);
- e. Converting the billing information for electronic transmission and transmitting the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53);
- f. Routing the billing information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Comesanas also does not disclose the feature in Claim 30 wherein the switch routes all of the record to the printer if the server fails or is taken out of service. Official Notice is taken that it is old and well known with the communications art to redirect output to another format/device when part of the network fails or is otherwise not available. In this instance, it would have been obvious to one having ordinary skill in the art at the time of invention was made to redirect the

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electronic bills in the Comesanas invention to the printer and to then transmit the bills through the normal postal channels. One would have been motivated to do so in order to facilitate timely transmission of the bills and receipt of payments, thus decreasing the financial loss to the crediting organization and to the customer (through the levying of “late charges”).

Finally, while Comesanas discloses retrieving the customer’s billing preference from a database, it is not explicitly disclosed whether this is the same database that contains the billing data or a separate database. Official Notice is taken that it is old and well known within the database arts that data may be stored in one, two, or more databases and then combined as needed. This is referred to as a multidatabase (MDBS) system and has been in use for many years. One of the main advantages of an MDBS is its ability to “access data from a variety of preexisting” (legacy) “databases located in various heterogeneous hardware and software environments.” (Korth and Silberschatz, “Database System Concepts”, 1991, page 518). It is also common for businesses to store transaction information (billing data) in one file or database and to store customer data (such as name, address, phone, billing and payment preferences, etc.) in a different file or database, and then extract the needed data when compiling bills, reports, etc. The two main reasons that this data is kept separate is: (1) to decrease the required storage space by eliminating storing duplicate information, such as the customer’s name and address, with each transaction completed during the billing period; and (2) to facilitate updating the customer’s data, such as address, by eliminating the need to search for and replace every instance of the data if duplicate data is maintained as in (1) above. Therefore, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to maintain the customer data in the Comesanas invention in a database separate from the billing data. One would have been motivated to maintain separate databases for the reasons discussed above.

Claims 22 and 27: Comesanas discloses an automated billing system and method as described in Claims 21 and 26 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database.

Claims 23 and 34: Comesanas discloses an automated billing system and method as in Claim 21 and 30 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 25, 29, and 36: Comesanas discloses an automated billing system and method as described in Claims 21, 26, and 30 above and further discloses a means to electronically transmit funds to the biller (col 3, lines 13-24).

Claim 31: Comesanas discloses an automated billing system and method as described in Claim 30 above, and further discloses the billing server containing billing information about a plurality of recipients (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

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Claim 33: Comesanas discloses an automated billing system and method as described in Claim 31 above, but does not disclose that each record is sanitized. Examiner notes that Applicant has defined “sanitized” in the specification (page 3, lines 24-27) as a filter “which performs a number of convenient functions, such as verifying and/or correcting the accuracy of a customer’s address, etc.”. Official Notice is taken that it is old and well known within the accounting and database arts to verify and correct data such as addresses, phone numbers, etc. in order to maintain the most up-to-date database as possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a means to verify and correct the information within the databases in Comesanas. One would have been motivated to verify and update the information to ensure that the bills are directed to the correct address, thus precluding the wasteful expenditure of time and funds.

7. Claims 16, 24, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498) in view of Hogan (5,699,528).

Claim 16: Comesanas discloses an automated billing system as in Claim 12 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas’ electronic billing

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processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

Claims 24, 28, and 35: Comesanas discloses an automated billing system as in Claim 21, 26, and 30 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

Response to Arguments

8. Applicant's arguments filed June 13, 2002 have been fully considered but they are not persuasive.

a. Applicant's arguments in reference to the 37 CFR 1.132 affidavit and the lack of diligence have been discussed at length in paragraph 3 above.

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b. Applicant argues in reference to the Comesanas reference that it is not disclosed that the use of printed or electronic transmittal is based on the prescribed preferences of the customers (page 9). As discussed in the rejection of Claims 12 and 18 in paragraph 6 above, Comesanas explicitly discloses that the system will determine “whether each of said invoices is to be sent electronically or by mail” (col 4, lines 50-52). This determination is based on whether or not the customer has agreed to pay the transmittal charges associated with electronic transmission. As the Applicant noted, these preferences are pre-authorized by the customer. Therefore, the customer has indicated his preference on receiving the bill electronically or by mail; and this stored preference is used to determine the mode of transmission that will be used to delivery the bill to the customer.

c. The Applicant argues in reference to the Hogan reference that it does not disclose the features noted above as missing from Comesanas. The Examiner notes that Comesanas does disclose these features, as discussed in 8b above, and that Hogan discloses the additional features in dependent claims 16, 24, 28, and 35 as discussed in paragraph 7 above.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Hilt et al 6,408,284) discloses a system and method for generating messages to financial institutions to pay bills to overcome the "exception" items wherein a biller receives both paper and electronic payments (from paper and electronic bills).

b. Delfer, III (5,774,885) discloses a system and method for combining bills, advertisements, and other documents into one mailing envelope. A centralized biller/mailler is used to decrease the number of envelopes needed by a plurality of billers.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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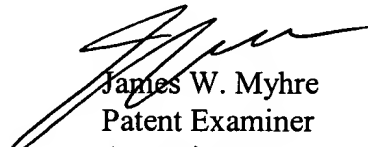
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



July 30, 2002



James W. Myhre
Patent Examiner
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